REMARKS

Upon entry of the present amendment, claims 1-8 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, the amendments made to claims 1 and 2 find support at page 6 of the specification, lines 18-21. The amendments to claims 7-8 simply clarify that the catalyst is an "oxidation catalyst" as already recited in claims 1-2 from which claims 7-8 respectively depend.

Claim Objections

The Examiner has objected to claims 7-8, reconsideration and withdraw of the objection is required based on the amendment of claims 7-8 herein to refer to an "oxidation catalyst".

Claim Rejections – 35 USC § 112, Second Paragraph

Claims 2-6 and 8 are rejected under the provisions of 35 USC § 112, Second Paragraph. Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Claim 2 is directed to an oxidation catalyst composition containing an organic solvent as component (ii), which finds support at page 6, lines 18-28 of the specification, wherein it is described that:

> *The oxidation catalyst composition of the present production method can be obtained by reacting aqueous hydrogen peroxide with at least one metal or metal compound as described above to form the catalyst composition as a homogeneous solution or a suspension, both of which can be used. ... The organic solvent as described above may be used to produce the catalyst composition containing the organic solvent, which may be further dehydrated prior to use, if necessary. Typical*

examples of the dehydrating agents include anhydrous magnesium sulfate, anhydrous sodium sulfate, anhydrous boric acid, polyphosphoric acid, diphosphorous pentaoxide and the like.

As such, it is submitted that claim 2 as currently drafted, and dependent claims 3-6 and 8, particularly and distinctly set forth the subject matter that the applicants regard as their invention and are thus fully acceptable under the provisions of 35 USC § 112, Second Paragraph. Any contentions of the Examiner to the contrary must be reconsidered.

Claim Rejections Under 35 USC § 102(b)/103(a)

Claims 1-8 have been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over YOUNG et al. (US 3,893,947). Reconsideration and withdrawal of this rejection is respectfully requested based upon the following considerations.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Obviousness

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

In the presently pending claims it is provided that the oxidation catalyst composition is obtained as "a homogeneous solution or a suspension" *(see claim 1),* or comprises a composition obtained "as a homogeneous solution or a suspension" *(see claim 2).* In contrast, the cited Young et al. US '947 reference provides for a calcined catalyst.

As such, it is impossible for the disclosure of the cited Young et al. US '947 reference to either anticipate or render the instant invention obvious as recited in pending claims 1-8. This is because the cited Young et al. US '947 reference fails to teach or provide for each of the limitations recited in the pending claims and because those of ordinary skill in the art would in *no* way be motivated to arrive at the present invention as claimed, after considering the teachings and disclosure of Young et al. US '947

Further, it is noted that even though pending claim 5 recites "The oxidation catalyst composition according to claim 4, which is dehydrated", the same is *not* directed to a calcined catalyst, since claim 5 ultimately depends from claim 2, which again recites an oxidation catalyst composition that comprises a composition obtained "as a homogeneous solution or a suspension".

Accordingly, it is submitted that the outstanding anticipation and obviousness rejections based on the disclosure of Young et al. US '947 must be withdrawn at present.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 1-8 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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